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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,705	03/27/2006	Katsumi Tokumoto	287610US0PCT	7106
22850 7590 04/21/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER COONEY, JOHN M				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
04/21/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/573,705

Applicant(s)

TOKUMOTO ET AL.

Examiner

John Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 8-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's arguments filed 12-22-09 have been fully considered but they are not persuasive.

Election/Restrictions

Group 1, claims 1-7, have been examined.

Elected amine compound (A), tetramethylammonium acetate, has been examined.

Elected amine compound (B), N,N-dimethyldodecylamine, has been examined.

Elected amine compound (C), 1,2-dimethylimidazole, has been examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17 & 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' originally filed supporting disclosure lacks support for the ranges of weight ratio values now claimed. The limited disclosure of values associated with the now defined range of values for specific compositions within the ranges of materials encompassed by the scope of applicants'

claims are insufficient in supporting the invention now defined by this claim. This is a new matter rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zama et al.(5,171,787).

Zama et al. discloses condensation catalyst which may include the elected catalysts of applicants' claims (see column 6 lines 19-31).

Zama et al. differs from applicants' claims in that selection of more than one of the selected catalysts is not required. However, the reference is clear in its disclosure of the catalysts and their function of catalyzing condensation reactions, and it has been held by the court that "it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980)(M.P.E.P. 2144.06 I.) and the mere duplication of parts has no patentable significance unless a new or

unexpected result is produced. (See *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), as well as, M.P.E.P. 2144.04 VI. B.). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed multiple catalysts of Zama et al. in the formation of preparations of Zama et al. for the purpose of duplicating their effect in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Claims 4-7, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zama et al. as applied to claims 1-3, 16 and 17 above, and further in view of Decker et al.(5,997,954).

Claims differ in that they do not employ the elected compound (C) of applicants' claims. However, Decker et al. discloses 1,2-dimethylimidazole to be a well known condensation catalyst (column 6 lines 45-53). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the 1,2-dimethylimidazole condensation catalyst of Decker et al. as a condensation catalyst in the preparations of Zama et al. for the purpose of imparting its condensation catalytic effect in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. Hereto it applies that "it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been

individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980)(M.P.E.P. 2144.06 I.) and the mere duplication of parts has no patentable significance unless a new or unexpected result is produced. (See *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), as well as, M.P.E.P. 2144.04 VI. B.).

Applicants' arguments have been considered. However, rejections are maintained.

Contrary to applicants' statements on reply, it is "tetramethylammonium acetate" that has been elected for examination as Amine Compound (A). Though it is noted that applicants' Restriction Response received 4/20/09 incorrectly refers to "Catalyst A1" {Catalyst A2 is the elected "tetramethylammonium acetate" in the Tables and Examples of applicants' invention} in the election of "tetramethylammonium acetate" as the Amine Compound (A) for examination, it is the actual species identified by name, "tetramethylammonium acetate", that controls in determining what species was elected by applicants in their Restriction Response.

Consideration of applicants' arguments and discussion of results have been considered. However, the results discussed do not correlate with the invention that has been examined. There are no showings of new or unexpected results identified that show unexpected results attributable to the examined combinations of elected Amine Compound (A) and elected Amine Compound (B) (tetramethylammonium acetate with N,N-dimethyldodecylamine) or combinations of elected Amine Compound (A), elected

Amine Compound (B) & elected amine compound (C) (tetramethylammonium acetate with N,N-dimethyldodecylamine & 1,2-dimethylimidazole). Further, regarding results, it is seen that comparisons would need to show comparative showings demonstrating new or unexpected results attributable to combinations of (A) and (B) representative of the ratios of amounts of (A) and (B) encompassed by the claims as they currently stand. Similarly, for claims including (A), (B) and (C), comparatives would need to show criticality associated the combination of the three components, and such a showing would need to be commensurate in scope with the range of ratios of amounts encompassed by the claims.

There are currently no showings of record demonstrating criticality for the elected combination of (A) & (B), for the elected combination of (A),(B), and (C), or, correspondingly, for the ranges of ratios of amount values of the respective elected components encompassed by the claims.

Further, the results of record can not be correlated to the combinations of record because it has not been established on the record by applicants that the individual species of each of Amine Compound (A), (B) & (C), respectively, are obvious variants of one another.

Though the results discussed in applicants' reply may be associated with effects that could be seen as new or unexpected, a determination of whether the results are, in fact, new or unexpected can not be made because they can not be associated with the invention that has been examined and is rejected in the rejections above.

As to new claims 16-19, these claims identify differing arrangements of species which include the elected species addressed above. Accordingly, they are not withdrawn. However, they are addressed by the rejections and remarks hereinabove. As to the ranges of amount values identified in these new claims, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of the same properties. *Titanium Metals v Banner* 227 USPQ 773. **(see also MPEP 2144.05 I)** Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980). It is held and maintained that criticality has not been established for these new ranges of values claimed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/
Primary Examiner, Art Unit 1796